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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/792,038	03/03/2004	Melissa K. Rath	ATMI-668	4823
24239 7590 05/06/2008 MOORE & VAN ALLEN PLLC P.O. BOX 13706 Research Triangle Park, NC 27709				
EXAMINER				
LE, HOA VAN				
ART UNIT		PAPER NUMBER		
1795				
MAIL DATE		DELIVERY MODE		
05/06/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/792,038

Applicant(s)

RATH ET AL.

Examiner

Hoa V. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4-7, 10, 14, 15, 17-21, 24-31, 33-36, 39, 43-50 and 53-59 is/are pending in the application.
- 4a) Of the above claim(s) 4, 6, 7, 14, 20, 24-31, 33-36, 39, 43-50, 54, 55, 58 and 59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5, 10, 15, 17-19, 21, 53 and 56 is/are rejected.
- 7) ☒ Claim(s) 57 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

This is in response to Papers filed on 02/19/08.

I. There has been on the record:

“ The record shows that applicants elect specie of Formula G. It is that:

(1) Upon the allowance of a generic claim (especially, the instant claim 1 is read on the elected Formula G specie) ", applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

(2) An application of one (claim 1) or more claims over an applied prior art is not depended on a claim is depended on claim 1. But the applied prior art is sufficient to rejected claim 1 as required and may be one or more of the claims that are depended on claim 1. Applicants should urge, show and state on and for the record that that one or more claims are sufficiently and/or perfectly objected and/or rejected as that of claim 1 using the same applied issue or prior art.

(3) The elected Formula G with “0.10” of the mixture “oxirane” (being known in the art as ethylene oxide gas form), (“methyl-, polymer with oxirane or mono(octylphenyl)ether” as claimed (has been considered and searched as an agent being in a mixture with an amount of an ethylene oxide gas. A reading in any other way is an issue of a new matter)). The elected species have not been found.

II. The newly amendment language:

wherein the oxirane species comprises a species selected from the group consisting of: oxirane, methyl-, polymer with oxirane, ether with 2,2'-(oxidoimino)bis(ethanol) (2:1), N-(3(C9-11-isoalkyloxy)propyl)derivatives, C₁₂-rich, and oxirane, methyl-, polymer with oxirane, mono(isocyclohexyl)ether

being acknowledged. The “oxirane...” with some of them in Formula G have been considered and searched with as agent being in a mixture with an amount of an ethylene oxide gas. Other non-elected species will be considered and searched as agent being in a mixture with an amount of an ethylene oxide gas. A reading in any other way is an issue of a new matter. The Office has tried its best to accommodate applicants’ amendments and arguments. However, one may and should disagree and challenge under an issue of new matter since a benefit may be found and obtained since applicants have a duty to fully, completely and satisfactory answer and provide each of all supports for each of all issues of a new matter to a full and complete satisfaction first before taking and/or going to any other issue.

III. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438,

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164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 4-7, 9-10, 14-15, 17-21 and 53-57 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7, 9-17, 21-22 and 33-48 as amended on 17 August 2007 of copending Application No. 10/389,214 (and its teachings and suggestions in the specification on at least paragraphs 9, 12, 13, 17, 18, 21, 23, Examples 2, 4 and 5). Applicants, assignee and their counsel may and should disagree, urge and state on and for the record that each of the claims as originally filed is self sufficient. There has not been and will not be relied on any embodiment and any application for any purpose) considered in view of En et al (2004/0134682).

Applicants in the application do not specify an alkali base. However, it is known in the art at the time the invention was made to obtain and use an alkali base for the advantage of providing a sufficient alkalinity and stripping power. Evidence can be seen in at least En et al at paragraph 0550, 0600, 0612, 0620, 0653, 0714, 0754 and 0774.

The ability or capability of “removing...” or the like is a property of a material and considers inherent. For a patentability of a property of a material embodiment, it is allowed by law to request and require applicants to convincingly show or provide an evidence to the contrary since arguments alone are not a factual evidence in accordance with the authority

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stated in *In re Schreiber*, 44 USPQ2d 1429. An allowed claim or patent would have no value when someone later arrives to the same or obviously the same claimed functional property as set forth on the record using all possible combinations of the teachings and suggestions in the applied reference. A showing should be submitted in the next response to this Office action in order for it to be considered timely.

Since the above references are all related to cleaners and/or removers, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use or cite potassium hydroxide alkaline agent for a reasonable expectation of sufficiently providing an additional alkalinity and stripping power to one having ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicants should made the same statement for claims 24-31, 33-36, 39, 43-50 and 58-59 for a later possible rejoinder.

There is on the record:

"It is noted that the earlier co-pending application, U.S. Patent Application No. 10/389,214 is still pending.

If in the future, co-pending U.S. Patent Application No. 10/389,214 remains rejectable on other grounds, the obviousness-type double patenting rejection is the only rejection remaining to the presently pending case AND the presently pending claims are an obvious variation of the invention defined in claims 1-7, 9-17, 21-22 and 33-48 of co-pending U.S. Patent Application No. 10/389,214 in view of *En et al.* (which can only be objectively assessed when the only rejection remaining in the presently pending case is the obviousness-type double patenting rejection), applicants will submit the required terminal disclaimer."

There will be no indication of an allowance when there is no proper and timely file terminal disclaimer being checked and approved by a specialist on and for the record.

There will be no separate consideration of a terminal by itself. Applicants are requested and required to refile the application in order for a terminal disclaimer to be considered by itself. It is now early and timely notified and set forth on and for the record.

IV. Claims 1, 2, 5, 10, 15, 17, 18, 19, 21, 53 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pasch (6117795) considered in view of Ward et al (7309559).

Pasch discloses, teaches and suggests a cleaning solution comprising an amine-based cleaning agent(s) (2-(2-aminoethoxy) ethanol and/or catechol) with an alternative hydroxylamine and a mixture containing at least hydroxylamine being in not suggested or applied in this rejection (col. 3:16-18) and a thiazole corrosion inhibitor. Please see the whole disclosure of each of the applied references, especially in Pasch at least on col.2:57-62. The language “chelator”, “useful for...” is a property of capability of a material. For a property or capability of an embodiment in a claim, it is allowed to request and require applicants to

provide a convincing evidence to the contrary since arguments alone is not a factual evidence. An allowed claim or patent would have no value when someone reasonably shows to the same or obviously about the same property.

Pasch does not specify additional quaternary base and alkali base. However, it is known in the art to disclose, teach and suggest the use of additional and strong quaternary base and alkali base in a cleaning solution at the time the invention was made for an additional cleaning power. Evidence can be seen in at least Ward et al on at least col.2:56-62, 3:4-6, 38-68 and 5:25.

Since the above references are all related to cleaning solutions, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include or cite strong quaternary base and alkali base for a reasonable expectation of obtaining a cleaning power to one having ordinary skill in the art as disclose, teach and suggest in the secondary reference.

V. Claims 1, 2, 5, 10, 15, 17, 18, 19, 21, 53 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ward et al (7309559) considered in view of Pasch (6117795).

Ward et al disclose, teach and suggest a cleaning solution comprising a quaternary base, alkali base. Please see the whole disclosure of each of the applied

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references, especially in Ward et al at least on col.2:56-62, 3:4-6, 38-68 and 5:25. The language “chelator”, “useful for...” is a property of capability of a material. For a property or capability of an embodiment in a claim, it is allowed to request and require applicants to provide a convincing evidence to the contrary since arguments alone is not a factual evidence. An allowed claim or patent would have no value when someone reasonably shows to the same or obviously about the same property.

Ward et al do not specify thiazole corrosion inhibitor in their cleaning solution. However, it is known in the art to disclose, teach and suggest the use of thiazole corrosion inhibitor in a cleaning solution at the time the invention was made for an additional cleaning power. Evidence can be seen in at least Ward et al on col.2:60-62. An alternative hydroxylamine and a mixture containing at least hydroxylamine being in not suggested or applied in this rejection (col. 3:17).

Since the above references are all related to cleaning solutions, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include or cite the known use of thiazole corrosion inhibitor for a reasonable expectation of obtaining a metal corrosive inhibiting property to one having ordinary skill in the art as disclosed, taught and suggested in the secondary reference.

VI. Applicants' arguments have been considered. However, in view of the amendment, the above rejections are applied with new sets of references.

VII. Chemical ingredients and their amounts of the elected Formula G in claim 7 have been considered and searched. The same are with its closely related claim 57 and not found. In the absence of a pertinent reference again the elected Formula G and claim 57, no rejection is made. However, the elected Formula G and claim 57 are objected to but would be allowable if each of them is rewritten in an independent form.

VIII. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the

advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

IX. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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/Hoa V. Le/
Primary Examiner, Art Unit
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